

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Niranjan Damera-Venkata Art Unit : 2625
Serial No. : 10/698,899 Examiner : Kau, Steven Y
Filed : October 31, 2003 Confirmation No.: 3010
Title : EMBEDDING INFORMATION IN IMAGES

Commissioner for Patents
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RESPONSE TO ELECTION REQUIREMENT

In the Office action dated October 25, 2007, the Examiner has indicated that an election is required between the asserted "species" I and II. In response to this election requirement, applicant provisionally elects "species" I with traverse. Claims 1-11 and 29-34 read on the elected "species" I.

As explained in detail below, however, the election requirement is submitted to be improper because: (I) it would not be a serious burden for the Examiner to continue examining the application on the merits without the Election Requirement; (II) the Examiner is not authorized under the Rules to issue the Election Requirement; (III) the Examiner has failed to establish a *prima facie* case for requiring an election of the claims; and (IV) no valid reason exists for dividing among the asserted "species".

I. IT WOULD NOT BE A SERIOUS BURDEN FOR THE EXAMINER TO CONTINUE EXAMINING THE APPLICATION ON THE MERITS

MPEP § 803.01 provides that (emphasis added):

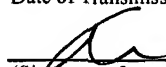
If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the

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merits, even though it includes claims to independent or distinct inventions.

The Examiner already has searched and examined the entire application on the merits before issuing the above-mentioned Election Requirement. The Examiner's Election Requirement therefore is improper at the present stage of prosecution because it would not be a serious burden for the Examiner to continue examining the application on the merits without the Election Requirement.

A summary of the prosecution history of the application is set forth below.

10/31/03 The application was filed with:

claims 1-11 and 29-34 respectively relating to a method and an article for embedding information into an image;

claims 12-20 and 35-38 respectively relating to a method and an article for extracting information from an image; and

claims 21-28 relating to apparatus comprising an encoder for embedding information into an image and a decoder for extracting information from an image.

5/17/07 The Examiner mailed the first Office action on the merits in which the Examiner examined all of the pending claims and issued the following claim rejections:

claims 2, 3, 7, 16, 23, 26, 31, 34, and 37 rejected under 35 U.S.C. § 112, second paragraph, "as being indefinite.";

claims 1-11, 21-27, 29-34, and 35-38 rejected under 35 U.S.C. § 103(a) over Curry (U.S. 5,710,636) in view of Sandford (U.S. 5,778,102) and Lapstun (U.S. 6,512,596);

claims 12-20 and 28 rejected under 35 U.S.C. § 103(a) over Choi (U.S. 2004/0071311) in view of Yu (2003/0174857), Curry (U.S. 5,710,636), and Sandford (U.S. 5,778,102).

8/17/07 Applicants mailed an Amendment in which claims 1-9, 13-18, 21-38 were amended. These amendments, however, preserved the original relationships between the subject matter defined in the claims and the embodiments disclosed in the specification. In particular,

claims 1-11 and 29-34 still respectively relate to a method and an article for embedding information into an image;

claims 12-20 and 35-38 still respectively relate to a method and an article for extracting information from an image; and

claims 21-28 still relate to apparatus comprising an encoder for embedding information into an image and a decoder for extracting information from an image.

10/25/07 The Examiner mailed the election requirement that is the subject of the instant Petition.

The Examiner already has fully and completely searched and examined both of the asserted "species" on the merits in the first Office action dated May 17, 2007. In particular, in the Office action dated October 25, 2007, the Examiner is requiring applicant to elect between the asserted "species" I, which corresponds to the encoder 220 shown in FIG. 3, and the asserted "species" II, which corresponds to the decoder 260 shown in FIG. 4. In the first Office action, however, the Examiner fully and completely searched and examined:

- the original claims 1-11 and 29-34, which relate to the encoder 220;
- the original claims 12-20 and 35-38, which relate to the decoder 260; and
- the original claims 21-28, which relate to both the encoder 220 and the decoder 260.

Although independent claims 1, 21, 29, and 35 have been amended, these amendments did not change the invention defined in these claims to a species that is different from the species originally defined by these claims.

Therefore, it would not be a serious burden for the Examiner to continue examining the application on the merits, regardless of whether the application includes claims that are independent and distinct.

For at least this reason, Applicant request that the Examiner reconsider and withdraw the election requirement.

II. THE EXAMINER IS NOT AUTHORIZED TO ISSUE THE ELECTION REQUIREMENT

The Examiner is not authorized to issue the election requirement data October 17, 2007, because the Rules do not permit the Examiner to issue an election requirement at the current stage of prosecution.

The election requirement is traversed because the Examiner is not authorized to require the proposed election of "species". In particular, 37 CFR 1.146, which authorizes the Examiner to require an election of species, applies only to "... the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby..." The instant application was filed with a generic claim to an invention generic to the asserted "species" asserted by the Examiner (e.g., claim 21 relating to both the encoder 220 and the decoder 260; see MPEP § 806.04(e)) and separate sets of claims to each of the asserted "species" (i.e., claims 1-11 and 29-34 relating to the encoder 220, and claims 12-20 and 35-38 relating to the decoder 260). In the first Office action, the Examiner did not "require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted," as provided in 37 CFR § 1.146. Instead, the Examiner fully and completely searched and examined on the merits claims relating to both of the asserted "species".

Thus, the Examiner is not authorized under 37 CFR § 1.146 to issue the election of species requirement at the present stage of prosecution. The Examiner also is not authorized to issue the election of species requirement under 37 CFR § 1.145 because applicant did not present any claim that is directed to an invention distinct from and independent of the invention previously claimed.

For at least this additional reason, Applicant request that the Examiner reconsider and withdraw the election requirement.

III. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE FOR
REQUIRING THE PROPOSED ELECTION OF CLAIMS

In the Office action dated October 25, 2007, the Examiner has required an election between species I relating to the encoder 220 shown in FIG. 3 and species II relating to the decoder 260 shown in FIG. 4.

The specification discloses that the asserted "species" I and II are related. For example, the specification discloses a computer system 100 that includes an encoding process 114 that corresponds to the asserted "species" I and a decoding process 116 that corresponds to the asserted "species" II (see, e.g.: page 3, ¶¶17-20; and FIG. 1).

In the case of related inventions, MPEP § 806.05(j) explains that, for related product inventions or related process inventions that are not in a combination/subcombination relationship, the inventions are distinct if (emphasis added):

- (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions as claimed are not obvious variants; and
- (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

The burden is on the examiner to provide an example to support the determination that the inventions are distinct, but the example need not be documented.

The Examiner has given the following explanation in support of the election requirement is that:

The species are independent or distinct because claims to the species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

In this explanation, the Examiner has attempted to address prong (A) of MPEP § 806.05(j) with the statement that “claims to the species recite the mutually exclusive characteristics of such species.”

The Examiner also has attempted to address prong (B) of MPEP § 806.05(j) with the statement that “these species are not obvious variants of each other based on the current record.” This statement, however, is inadequate to make the showing required under prong (B). In particular, MPEP § 808.01 explains that (emphasis added):

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

With respect to prong (B) of MPEP § 806.05(j), the Examiner's statement that “...these species are not obvious variants of each other based on the current record” amounts to no more than a statement of conclusion that, under MPEP § 808.01, is inadequate to support the required election among species.

The Examiner has not provided any showing whatsoever that the required prong (C) of MPEP § 806.05(j) is met by his proposed election requirement.

Thus, the Examiner's election requirement is premised solely on his conclusion that the asserted “species” are mutually exclusive from each other. Under MPEP § 806.05(j), however, mutual exclusivity is insufficient by itself to establish that the species are either independent or distinct. Therefore, the Examiner has not made the showing required under MPEP § 806.05(j) and, consequently, has not established a *prima facie* basis for requiring election between each of the asserted “species” I and II.

For at least this additional reason, Applicant request that the Examiner reconsider and withdraw the election requirement.

IV. No Valid Reason Exists for Dividing Among the Related Inventions

In general, if “the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions” (MPEP § 808.02).

In support of the proposed election of species, the Examiner has stated that:

There is an examination and search burden for these patentable distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g. searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C.112, first paragraph.

In this statement, however, the Examiner has not provided any basis for believing that the classification of the asserted "species" I and II is not the same, nor has the Examiner provided any basis for believing that the field of search of the asserted "species" I and II is not the same. Instead, the Examiner's rationale amounts to no more than a collection of unsupported conclusory statements. Moreover, the fact that the Examiner already has examined the subject matter corresponding to the asserted "species" I and II in the first Office action (see § I above) evidences the fact that the classification of the asserted "species" I and II is the same and the field of search of the asserted "species" I and II is the same. The Examiner also has not provided any clear indication that the classification of the asserted "species" I and II would be different in the future. Thus, the Examiner has not shown that separate examinations are required for the asserted "species" I and II. Accordingly, under MPEP § 808.02 "no reasons exist for dividing among related inventions" and the election requirement should be withdrawn.

For at least this additional reason, Applicant request that the Examiner reconsider and withdraw the election requirement.

V. CONCLUSION

For at least the reasons explained above, Applicants request that the Examiner reconsider and withdraw the election requirement.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

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Serial No. : 10/698,899
Filed : Oct. 31, 2003
Page : 8 of 8

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Respectfully submitted,

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